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Serial No. 09/723,868
Docket No. FANEUF 00.02
Amendment F under Rule 116

REMARKS

Claim has been amended to address the §112 rejection, and to place the Application in better form for Appeal. No new issues have been raised by the Amendment, which would require further search or consideration by the Examiner, the amendment to claim 2 being made solely to address a minor language objection. Accordingly, it is believed that the subject Amendment should be entered for the purposes of Appeal.

In rejecting the claims as obvious, the Examiner starts with the Applicant's admitted prior art (APA) and takes the position "it is not considered to be outside the realm of obviousness for the APA clip, having been disclosed as prior art, to be used in conjunction with a rope as it is known to use clips in conjunction with a rope for culling fish ..." (underlining added for emphasis). As noted in Applicant's Amendment A, which is incorporated herein by reference, in establishing a *prima facie* case for obviousness under 35 USC §103, it is incumbent upon the Examiner to provide a "clear and particular" showing of "actual evidence" of a suggestion, teaching or motivation to combine references. In re Dembiczak, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999). The Examiner's own characterization of the rejection "not considered to be outside the realm of obviousness" bespeaks to the Examiner's improper use of hindsight in rejecting the claims as obvious from the art.

In cipher 2 of the Action, the Examiner states "[i]t is considered to be within the skill of an artisan in the art to try any known clip, irrespective of intended prior use, and to have a reasonable expectation of success with the clip for the intended purpose ...". Even assuming *arguendo* the Examiner's position (which Applicant does not), Applicant's APA claim is not "any known clip." Applicant's APA clip is unique in that when one secures a loop of rope to the

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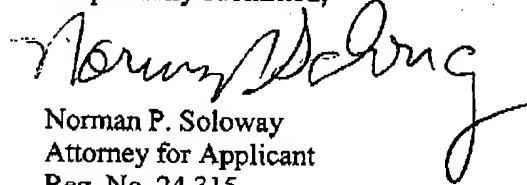
clip, the rope is capable of exerting a force on the biasing member, thereby increasing the gripping force. This is an unexpected feature and advantage not seen or achievable with "any known clip." All of Applicant's independent claims 1, 12 and 21 specify that the loop securing the length of rope to the clip is "capable of exerting a force on the biasing member thereby increasing the gripping force" [of the clip]. Johnson does not teach this, but rather teaches just the opposite. In Johnson, a pull or weight on the rope would tend to open the clip. Thus, Johnson is diametrically opposed to Applicant's claimed invention in object, construction and effect.

It is therefore submitted that the continued rejection of the independent claims 1, 12 and 21 as obvious from Johnson in view of the APA, and the several claims dependent thereon, is in error.

The foregoing Amendment makes no claim changes that would require further search or consideration by the Examiner. Rather, the foregoing Amendment merely addresses a minor §112 language rejection. Accordingly, entry of the foregoing Amendment, and allowance of the Application are respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account Number 08-1391.

Respectfully submitted,


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